

REMARKS

This Response is submitted in reply to the Non-Final Office Action dated April 19, 2005. Claims 1 to 97 are pending. Claims 1, 21, 27, 52, 70 to 71, and 93 to 94 have been amended. Claims 9, 40, 56, and 79 are currently withdrawn from consideration. No new matter has been added.

A Terminal Disclaimer is submitted herewith. A check in the amount of \$130.00 is included in connection with the fee due under 37 C.F.R. §102(d) to cover the cost of the Terminal Disclaimer. Please charge deposit account number 02-1818 for any insufficiency of payment or credit for any overpayment.

Examiner has not acknowledged consideration of the foreign patents and other documents cited on PTO-1449, received on November 18, 2003, because the copies of references were not received. However, in accordance with 37 C.F.R. 1.98, a copy of the references does not need to be submitted if: (1) the earlier application was identified in an IDS and relied on for an earlier priority date; and (2) the information disclosure statement complies with 37 C.F.R. 1.98 § (a) – (c). A proper notification of the earlier filed parent application and PTO-1449 was provided in the IDS of November 18, 2003. A proper PTO-1449 also was filed with the parent application, now patent number 6,663,489. However for Examiner's convenience, a copy of the foreign patents and other documents is included with this Response. Application respectfully requests that Examiner acknowledge consideration of the prior art cited in PTO-1449 of November 18, 2003 and include an initialed copy with the next communication to Applicant.

The Office Action objected to Claims 1, 27, 70 to 71, and 93 to 94. Applicant, following suggestions made in the Office Action, has amended the claims to clarify any uncertainties. More specifically:

1. The Office Action objected to Claim 1 as including the letter "(e)". Applicant has amended Claim 1 to clarify that "(e)" is "(d)".
2. The Office Action objected to Claim 27, line 2, as including the word "tat". Applicant has amended Claim 27 to clarify that "tat" is "at".

3. The Office Action objected to Claim 70, line 2, as including the limitation "(a) to (c)". Applicant has amended Claim 70 to clarify that the limitation "(a) to (c)" is "(a) to (d)".
4. The Office Action objected to Claim 71, line 6 as including "; and". Applicant has amended Claim 71 to clarify that "; and" is ",".
5. The Office Action objected to Claims 93, line 8; and Claim 94, line 9 as including the limitation "selection set". Applicant has amended Claims 93 and 94 to clarify that "selection set" is "selection sets".

Accordingly, Applicant respectfully requests that these objections be withdrawn. These amendments have not been made to distinguish these claims over the prior art and Applicant respectfully submits that these amendments do not narrow the scope of the amended claims.

The Office Action rejected Claims 1 to 97 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 to 59 of U.S. Patent No. 6,663,489. Applicant is hereby submitting a Terminal Disclaimer as indicated in the Office Action to overcome these rejections over U.S. Patent No. 6,663,489.

The Office Action rejected Claims 1 to 8, 10 to 39, 41 to 55, 57 to 78, and 80 to 97 under 35 U.S.C. § 103 (a) as anticipated by Thomas et al. (US 6,190,255) in view of Vancura (US 6,852,028).

Thomas discloses a slot machine with a base game mode and a bonus game mode. A triggering event activates the bonus mode in the base game. Upon the triggering event in the base game, a player enters a bonus mode, whereby the player is provided with a set of player selectable game elements. (See Figs. 8 and 9). After a player has entered the bonus mode, the player can begin to select the player selectable elements and earn any awards associated with the player selectable elements until the player has selected an "end-bonus" outcome (e.g. the PARTY POOPER symbol). (See Column 10, lines 25 to Column 11, lines 13). In other embodiments, Thomas discloses

a slot machine with a plurality of triggering events that lead to the same bonus game; and a particular set of player selectable game elements is unique to each game.

Vancura discloses a slot machine with a base game mode and a bonus game mode. A triggering event in a base game starts a bonus game. In one version, the bonus game encompasses a player selection game, wherein depending on the triggering event, a player is given a variable number of selection opportunities to select a plurality of game elements. Certain game elements are associated with award values and/or additional selection opportunities. Two of the player selectable game elements, when selected in tandem, give a player an additional award. The bonus game ends when the player runs out of selection opportunities. The bonus game is continuous as long as the player has selection opportunities. When the bonus game is terminated, the player selections are not retained. Vancura further discloses a slot machine that removes player selectable elements after a player has selected an element. (See Columns 3-4). In another version, the player is provided with more than one selection set, each having a number of selection opportunities.

Amended Claim 1 is directed to a gaming device including, a selection set having a plurality of player-selectable selections and a plurality of awards associated with the selections of the selection set. The gaming device also includes a display device adapted to display the player-selectable selections of the selection set and a triggering event associated with a play of the game. After a first occurrence of the triggering event, a player is enabled to pick at least one of the plurality of selections in the selection set, whereby the number of player-selectable selections in the selection set is reduced by at least one selection. After the player selection, the player is enabled to pick from the reduced number of player-selectable selections upon a subsequent occurrence of the triggering event associated with the same play of the game. The game awards a player any awards associated with the picked selections.

As described above, the combination of Thomas in view of Vancura provides that a game has a plurality of selection elements within a set and a player can enter a selection game with an allotted number of selections. The game ends after the player has finished making all of the allotted selections. Unlike the gaming device of Claim 1,

the gaming device resulting from the combination of Thomas in view of Vancura does not disclose, teach or suggest that a player can select from a reduced number of selections upon a subsequent occurrence of the same triggering event that brought the player to the particular selection game. On the other hand, in the gaming device of Claim 1, after the player has made selections from the set, the player is enabled to select from the same selection set after the same triggering event occurs again. Although the same selection set is provided, the elements of the same selection set are reduced by the selections the player previously made. Thus, combination of Thomas in view of Vancura does not disclose, teach or suggest the presently claimed invention, because the selection set with a reduced number of player selections is not held for later play and the set with the reduced number of player selections will not again be provided upon a subsequent occurrence of said triggering event.

Additionally, the selection process resulting from the combination of Thomas in view of Vancura is continuous, while the gaming device of Claim 1 discloses that a player may wait for another occurrence of the triggering event before returning to the same selection set to make additional selections. Therefore, the combination of Thomas in view of Vancura does not disclose, teach or suggest the presently claimed invention because the selection portion of the combination is always continuous and does not have the possibility of a subsequent occurrence of a triggering event to reenter the same selection set. For these reasons, Applicant respectfully submits that independent Claim 1 is patentably distinguished over Thomas in view of Vancura and in condition for allowance.

Claims 2 to 8 and 10 to 20 depend directly from independent Claim 1 and are also allowable for the reasons given with respect to independent Claim 1 and because of the additional features recited in these claims.

Amended independent Claims 21, 52, and 71 each relate to a gaming device or a method of operating a gaming device including, amongst other elements, enabling a player to pick from a reduced number of player-selectable selections upon a subsequent occurrence of a triggering event associated with the play of the game. As described above, Thomas in view of Vancura does not disclose, teach or suggest

enabling a player to return to a previous selection set upon the subsequent occurrence of a prior triggering event, and that a player can select from a reduced number of player selections based upon earlier selections. Accordingly, for this reason and the reasons provided with respect to amended independent Claim 1, Applicant respectfully submits that independent Claims 21, 52, and 71 are patentably distinguished over Thomas in view of Vancura and in condition for allowance.

Claims 22 to 39 and 41 to 51; 52 to 55 and 57 to 70; and 72 to 78 and 80 to 93 depend directly from independent Claims 21, 52, and 71 respectively and are also allowable for the reasons given with respect to independent Claims 21, 52, and 71 and because of the additional features recited in these claims.

Claims 93 and 94 each relate to a gaming device or a method of operating a gaming device including, amongst other elements, a plurality of selection sets, a first and second triggering event associated with the selection sets, a player can make a further selection from a prior selection set upon the subsequent occurrence of a prior triggering event, and the selection set has a reduced number of player selections based upon a player's earlier selection. As described above, Thomas in view of Vancura does not disclose, teach or suggest the features that enables a player to return to a previous selection set after the subsequent occurrence of a prior triggering event and that a player can select from a reduced number of player selections based upon earlier selections. Additionally, Thomas in view of Vancura also does not disclose, teach or suggest enabling a player to return to a previous second selection set upon the subsequent occurrence of a prior second triggering event, and that a player can select from a reduced number of player selections based upon earlier selections from the same second selection set. Accordingly, for these reasons and the reasons provided with respect to amended independent Claim 1, Applicant respectfully submits that independent Claims 93 and 94 are patentably distinguished over Thomas in view of Vancura and in condition for allowance.

Claims 95 to 97 depend directly from independent Claim 94 and are also allowable for the reasons given with respect to independent Claim 94 and because of the additional features recited in these claims.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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BY



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